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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/971,851	11/17/1997	LOYD R HORNBACK III	53249USA5A	4843

32692 7590 09/26/2003

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EXAMINER

TRAN, HIEN THI

ART UNIT PAPER NUMBER

1764

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/971,851

Applicant(s)

HORNBACK III ET AL.

Examiner

Hien Tran

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: of the same reasons set forth in the final office action.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 26.Claim(s) objected to: none.Claim(s) rejected: 12-16, 18-20, 23-25, 27-31, 34 and 36-47.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: see attached sheets

Hien Tran

Hien Tran
Primary Examiner
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DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/02/03 have been fully considered but they are not persuasive.

Both claims 43 have inadvertently been cancelled in the previous amendment, the claim 43 (first occurrence) has been reconsidered, however, the same rejections regarding the different shape of the score line apply (note the final office action pages 5, 7).

Applicant alleges that a proposed drawing is resubmitted with the amendment. However, no drawing is found.

Applicant argues the negative limitation of "no score line" is supported by the drawings, Figs. 3B, 4B, 5B. Such contention is not persuasive as it has been held that any negative limitation or exclusionary proviso must have basis in the original disclosure. The mere absence of a positive recitation is not a basis for an exclusion. Although Figs. 3B, 4B, 5B positively show score lines proximate to the smaller radius of curvature, they do not exclude any score lines at the larger radius of curvature.

Applicant argues that the JP 61-89916 only shows grooves 1a extending only in the width direction of the sheet material, e.g. grooves 1a run the length of the mat, circumferentially about the honeycomb catalyzer and perpendicular to the gas flow. Such contention is not persuasive as although JP 61-89916 only shows the score lines extending in the length of the sheet material in Fig. 1, JP 61-89916 further discloses that any shape, any number or any arrangement means can be used for the score lines as long as to achieve the same effect (pages 3-4 of the translation of JP '916 - PTO: 99-3188).

It should be noted that it has been held that a disclosure in a reference is not limited to its specific illustrative examples, but must be considered as a whole to ascertain what would be realistically suggested thereby to one ordinary skill in the art. *In re Uhlig*, 54 CCPA 1300 376 F2d 320; 153 USPQ 460.

Applicant argues that the phrase of "arrangement means" is directed to the "method used to produce the grooves". Such contention is not persuasive as it is merely a statement. The examiner believes that JP '916 teaches that the score lines (grooves) can have any shape, any number or any arrangement means as long as to achieve the same effect of improving winding performance while maintaining excellent air-tight capability (pages 3-4 of the translation of JP '916 - PTO: 99-3188). Since the grooves can have any arrangement as set forth by JP '916, it would have been obvious to one having ordinary skill in the art to extend the groove in any directions, e.g. either the length or width, as long as to achieve the same effect of improving winding performance while maintaining excellent air-tight capability.

Applicant argues that if the grooves of JP '916 were positioned across the entire width, the sheet material would be unlikely to maintain its excellent air-tight capability since exhaust gas may flow through the spacing between the sheet material and the pollution control element. Such contention is not persuasive as JP '916 requires that the grooves in the sheet material are constructed so as to improve winding performance as well as to maintain excellent air-tight capability. JP '916 further discloses that after placing the mat (sheet material) in the gap between the catalyst and the casing, an excessive compressed force is applied to move the ridges 1b to the grooves 1a in order to improve sealing performance of the seal mat as required by JP '916. Since the ridges are moved into the grooves, the exhaust gas cannot flow therethrough.

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Furthermore, it is unclear as to whether the exhaust gas can flow through the score lines in the sheet material of the instant invention?

Applicant argues that it is not proper to ignore the differences between the instant invention and the prior art on the basis that the instant invention also discloses a less preferred embodiment which is disclosed in the prior art. Such contention is not persuasive as the differences, if any, between the instant invention and the prior art have been addressed in the final rejection and herewith. The fact that the instant invention discloses that the score lines can extend either the length or the width of the sheet material, shows that no unexpected results occur with different arrangements of the score lines. JP '916 further discloses that any shape, any number or any arrangement means can be used for the score lines as long as to achieve the same effect of improving winding performance while maintaining excellent air-tight capability.

Applicant argues with respect to Corn is noted. However, Corn is relied upon for teaching the oval shape of the catalyst.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

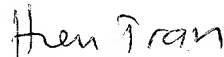
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hien Tran whose telephone number is 308-4253. The examiner can normally be reached on Tuesday-Friday from 7:30AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0661.

HT
September 24, 2003


Hien Tran
Primary Examiner
Art Unit 1764